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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) BRER.01US01
I hereby certify that this correspondence is being facsimile transmitted to the USPTO (571-273-8300) under 37 CFR §1.8 on <u>March 6, 2006</u> Signature <u>Cindy L. Pederson</u> Typed or printed name <u>Cindy L. Pederson</u>	Application Number 10/802,322  First Named Inventor BRENTON, BILLY H.  Art Unit 3724	Filed 3/16/2004  Examiner Phong H. Nguyen
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30,469</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>		
<p>This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p>If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.</p>		

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Applicant: Billy H. Brenton

Docket No.: BRER.01US01

Application No.: 10/802,322

Examiner: Phong H. Nguyen

Filed: March 16, 2004

Art Unit: 3724

For: ADJUSTABLE THUMB RINGLET FOR PIVOTED CUTTING INSTRUMENTS

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Advisory Action dated January 09, 2006, and the Office Action dated December 07, 2005, made final, in the above-identified patent application, applicant hereby submits a Pre-Appeal Brief Request for Review in accordance with the Pre-Appeal Brief Conference Pilot Program.

Applicant makes the following statement:

Claims 1-6, 8-14, 16, and 17 are currently pending in the above-identified patent application.

In the subject Office Action, made final claims 1, 3, 5, 8, 10, 11, 13, and 16 were rejected under 35 U.S.C. 102(b) as being anticipated by Nolen (U.S. Patent No. 590,330), since the Examiner stated that regarding claims 1, 3, 8, 10, 11, 13 and 16, Nolen shows the claimed invention. Further, the Examiner continued, Nolen's pin (a3) is considered "flexible" since virtually anything will flex if enough pressure is applied to it. The Examiner also stated that regarding claim 5, the rivet (a3) meets the claim language, since a rivet is a metal bolt or pin having a head on one end, inserted through aligned holes in the pieces to be joined and then hammered on the plain end so as to form a second head, and that before the plain end of the rivet (a3) is hammered, the rivet meets the claim language.

For the reasons to be set forth hereinbelow applicant believes that Nolen does not anticipate the present claimed invention; rather, Nolen clearly teaches away therefrom.

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Claims 2, 4, and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen; claims 6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Mock (U.S. Patent No. 6,131,291); and claims 9 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Brenton (U.S. Patent No. 5,469,624). As will be demonstrated hereinbelow, Nolen teaches away from the present claimed invention; thus, since there would be no motivation for one having skill in the art at the time the present invention was made to do so, the Examiner did not correctly use Nolen by itself or correctly combine Nolen with other references in the above rejections under 35 U.S.C. 103(a). Applicant therefore believes that the Examiner has failed to make a proper *prima facie* case of obviousness as is required under 35 U.S.C. 103(a) in the rejection of claims 2, 4, 6, 9, 12, 14, and 17.

Turning now the Examiner's interpretation of the word "flexible" in the subject claims, court decisions have addressed the interpretation of claims requiring that a material be flexible. For example, in *Harrington Mfg. Co. v. White*, 414 U.S. 1040, 179 USPQ 705 (1973), the court concluded that flexible in claims means adjustable. In Col. 2, lines 57-66, of Nolen it is stated that: "Upon the handle A<sup>2</sup>, adjacent to its rear end, is mounted a thumb-holder or ring, a<sup>2</sup>, preferably of sheet metal, pivoted thereto by means of a double-headed pin or rivet a<sup>3</sup>, headed loosely enough to permit said ring to be rotated on the surface of the handle in any direction desired and be retained generally at right angle or across the handle when the blades are pushed away from the operator." (emphasis added by applicant). In Col. 3, lines 4-9, it is stated that: "Although the thumb-handle A<sup>2</sup> is preferably provided with the ring a<sup>2</sup> as a thumb-retainer, the thumb-retainer may be in the form of a loop, as shown at a<sup>4</sup> in Fig. 6, that is pivottally retained by means of the double-headed pin a<sup>3</sup>." (emphasis added by applicant). Clearly, there is no adjustment possible in the rivet of Nolen, since the thumb ring of Nolen is retained generally at right angle across the handle when the blades are pushed away from the operator, as stated in the very specific language of Nolen: "... said ring to be rotated on the surface of the handle in any direction desired and be retained generally at right angle ... ." (emphasis added by applicant), and which specifically requires no flexibility of the rivet.

Further, *In re Gordon*, 735 F.2d 900, 221 USPQ 1125 (Fed. Cir., 1984) states that: "... The mere fact that the prior art could be so modified would not have made the ~~modification obvious unless the prior art suggested the desirability of the modification.~~"

Thus, if the flexible pin of the present invention were substituted for the pin of Nolen, as is

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suggested by the Examiner, the clearly recited function of the thumb ring of Nolen would be lost. Therefore, applicant believes that Nolen teaches away from the subject claimed invention.

More recently, in *Curtiss-Wright Flow Control Corp. v. Velan Inc.*, Fed. Cir. No. 05-1373, 2/15/06, the U.S. Court of Appeal for the Federal Circuit stated that the district court's reading places "too much emphasis on the ordinary meaning of 'adjustable' without adequate grounding of that term within the context of the specification." Judge Rader elaborated: "This case does not evince a situation where a party is attempting to import a limitation from the specification into the claims. Claim 14 already contains the 'adjustable' limitation. Thus, the claim construction task requires this court to discern the meaning in the context of this invention and field of art. The specification provides that context and substantial guidance on the meaning of 'adjustable.' In light of the specification, the term 'adjustable' means that the dynamic, live loaded seat can be adjusted while the de-heading system of claim 14 is in use." Page 6, lines 4-11, of the present Specification, as originally filed, states that: "Flexible pin 34 has been fabricated using Pebax® polyether block amides thermoplastic polymers ... having durometer values between about 220 and 750. Durometer values about 350 have been found to provided user comfort and ease of use of the scissors of the present invention. Other flexible materials can also be used, so long as they are durable, and permit the scissors to be sued in a comfortable and efficient manner." Applicant therefore believes that context in which the term flexible as used in the claims is adequately set forth in the subject Specification.

The Third Edition of The American Heritage Dictionary Of The English Language, copyright 1992 by Houghton Mifflin Company, defines a rivet as: "A metal bolt or pin having a head on one end, inserted through aligned holes in the pieces to be joined and then hammered on the plain end so as to form a second head." (emphasis added by applicant). The Fifth Edition of the Dictionary of Scientific And Technical Terms, copyright 1994 by McGraw-Hill, Inc. provides but a single mechanical definition for "flexiblility" as: "The quality or state of being able to be flexed or bent repeatedly." (emphasis added by applicant). As can be seen from the requirement of a rivet by Nolen, a metal pivoting device is contemplated. Clearly, a metal rivet as recited by Nolen cannot be flexed or bent repeatedly, since metals are well known to work harden and become brittle when flexed repeatedly. Thus, the rivet of Nolen does not meet the requirement of a "flexible pin" recited in subject claims 1 and 11, as originally filed.

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In the subject Office Action, the Examiner rejected claims 1, 3, 5, 8, 10, 11, 13, and 16 under 35 U.S.C. 102(b) as being unpatentable over Nolen (U.S. Patent No. 590,330, stating that Nolen shows the claimed invention, and that Nolen's pin (a3) is considered "flexible" since virtually anything will flex if enough pressure is applied to it. Applicant wishes to point out that the Examiner has quoted only a portion of the statement in *Fredman v. Harris-Hub Company, Inc.*; *Same v. Estee Sleep Shops, Inc.* 163 USPQ 397 (1969), and interpreted its meaning out of context. The complete quotation is: "The Court finds that the words 'flexibility' or 'rigidity' are relative terms, particularly since virtually anything will flex if enough pressure is applied to it. The Court finds that the Harris-Pub rails do not meet the first requirement of Claim 4 in that such rails are not designed to flex at their end portions and are not capable of being resiliently laterally deflected." The Court then went further, stating: "The lateral deflection referred to in Claim 4 is not insignificant in amount; the patent teaches that when each side rail is moved inwardly one inch the end portions of each rail are laterally deflected as much as one inch. ... In contrast, the accused Harris-Hub rails are not capable of such lateral deflection at their end portions; ... Claim 4 of the patent in suit is not infringed by any structure made, used or sold by either of the defendants herein."

Clearly, the Court is not applying the statement quoted by the Examiner in the manner in which the Examiner is applying this statement to the Nolen invention. The Court has stressed that flexibility is determined by the conditions under which the invention is used, rather than adhering to the statement that "... virtually anything will flex if enough pressure is applied to it." Certainly, if one placed the scissors of Nolen in a vice or grabbed the scissors with pliers, the rivet could be bent a couple of times before breaking. However, under the considerably reduced forces generated in a "comfortable" manner by the fingers of a barber, Nolen's rivet does not bend, and does not attain the adjustability of a flexible pin.

Regarding claim 5, the Examiner stated that the rivet (a3) meets the claim language, since a rivet is a metal bolt or pin having a head on one end, inserted through aligned holes in the pieces to be joined and then hammered on the plain end so as to form a second head, and before the plain end of the rivet (a3) is hammered, the rivet meets the claim language. Subject claim 5 recites: "... wherein said flexible pin has a forward portion and a rearward portion ... such that the forward portion of said flexible pin is captured in the tubular portion of said first shaft when said flexible pin is inserted therethrough." The rivet

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of Nolen is clearly not captured by handle (A2) as suggested by the Examiner. The rivet of Nolen is inserted therethrough before a second head is formed as clearly stated by the Examiner. Only then are the thumb ring (a2) and handle (A2) pivotably joined. Moreover, Nolen does not teach that thumb ring (a2) and handle (A2) are joined by a rivet wherein the plain end is not hammered. In fact, the invention of Nolen would not function with an incomplete rivet. Thus, as stated in *In re Gordon*, *supra*: "... The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." Thus, applicant believes that there would be no motivation to use a rivet for which the plain end was not hammered, and that the Examiner has used hindsight to teach the present claimed invention.

Applicant respectfully disagrees with the Examiner's assertion that Nolen shows the claimed invention except that it is silent about the material the pin (a3) is made of, and the location of the hole through which the pin (a3) extends with respect to the open portion of the thumb ringlet (a4), in the rejection of claims 2, 4, and 12 under 35 U.S.C. 103(a) as being unpatentable over Nolen, and the Examiner's conclusion that to select a well-known material such as plastic for Nolen's pin (a3) on the basis of its suitability for the intended use, would have been obvious to one having ordinary skill in the art. As noted hereinabove, Nolen clearly meant that a metal pin be utilized because a metal pin is the well-known meaning of the word "rivet," and a metal pin lacks adjustability as is required by Nolen.

In view of the arguments presented hereinabove, applicant believes that subject 1-6, 8-14, 16, and 17 are in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

COCHRAN FREUND &amp; YOUNG LLC

Date: March 06, 2006

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